

Appl. No. 09/974,853

Art Unit 1771

Reply to Office Action of January 13, 2005

REMARKS

Upon entry of the present amendment, claims 1, 3-5, 10 and 15 will remain pending in the above identified application and stand ready for further action on the merits.

The specification has been amended herein to correct a minor typographical error.

Claim 1 is amended herein to clarify that "the first and second sheets extend in the same direction" and that "the air-laid surface comprises numerous fibers having a fineness of 23 to 200 dtex". Each of these amendments to claim 1 finds support in the originally filed application (including the drawings thereof). Claim 15 has also been added to the application herein, in order to more particularly recite that "said first sheet is disposed on said second sheet", which finds support throughout the original application as filed, including the drawings thereof.

Based upon the above considerations, entry of the present amendment is respectfully requested.

Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 1 and 3-5 and 10 stand rejected under 35 U.S.C. § 112, second paragraph. Reconsideration and withdraw of the rejection is respectfully requested based on the following considerations.

A fundamental principle contained in 35 USC § 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

Claim 1 as instantly amended now recites that "the first and second sheets extend in the same direction" and that the air-laid surface "comprises numerous fibers having a fineness of 23 to 200 dtex." Based on such recitations, it is submitted that claim 1 and the rejected dependent claims based thereon (i.e., claims 3-5 and 10) fully meet the requirements of 35 USC § 112, second paragraph, as they particularly and distinctly set forth the inventive discovery that the applicants regard as their own, and at the same time are not indefinite or vague.

Issues Under 35 U.S.C. § 103(a)

Claims 1, 3-5 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '895 (JP 09-224895) in view of JP '761 (JP

10-060761) and JP '415 (JP 2000-328415). Applicants respectfully traverse the instant rejection and ask for reconsideration and withdraw thereof based on the following considerations.

Prima Facie Obviousness - Legal Standard

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there

is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Distinctions Over the Cited Art

The cited primary JP '895 reference discloses a sheet for cleaning that is composed of (i) a base material sheet 2 made of a nonwoven fabric, (ii) an intermediate sheet 3, which is a tacky adhesive, and (iii) a front surface 5 of a meshed fabric.

It is the Examiner's position that the base material sheet 2 of JP '895, which is made of a nonwoven fabric equates to the scraping part of the present invention and that the front surface 5 of the meshed fabric and/or the intermediate sheet 3 equates to the dust-holding part of the

present invention. However, such parts do not equate as contended by the Examiner!

Instead, if any thing in the JP '895 disclosure equates to the scraping part recited in the instant claims, it would have to be the front surface 5 of the meshed fabric in JP '895, since the base material sheet 2 in JP '895 does not serve as a cleaning area, and at the same time, the base material sheet 2 in JP '895 is folded over the top side of the flat plate part 13 (see Figure 2 of JP '895).

Additionally, the sheet disclosed in JP '895 does not have a low-friction part as instantly claimed. Also, JP '761 and JP '415 do not have a low friction part as recited in the pending claims, and thus are incapable of curing this deficiency in the primary JP '895 reference.

The secondary cited JP '415 reference relates to a nonwoven fabric which is used for absorbing liquids. JP '415 does not teach the use of a non-woven fabric in a dry form. In contrast, both of the JP '895 and JP '761 relate to a cleaning sheet of a dry form or type. Thus, it is submitted that the disclosure of JP '415 is not analogous to JP '895 and/or JP '761, and is not properly combinable therewith.

Based on such considerations, it is submitted that one of ordinary skill in the art would reach the conclusion that the cited art being applied against the pending claims is not capable of supporting an obviousness rejection of such claims. This is considered particularly true, inasmuch as such references in no way provide or teach the

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presence of the "low-friction" part like that recited in the pending claims.

CONCLUSION

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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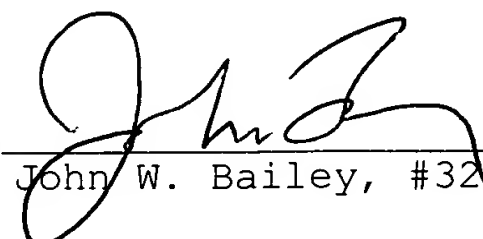
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Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By



John W. Bailey, #32,881

JWB/jwb
0445-0310P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000